

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3688

In re

Patent Application of

Martyn Ian Butterworth

Application No. 09/858,174

Confirmation No. 1570

Filed: May 15, 2001

Examiner: Jean D Janvier

“IMPROVEMENTS RELATED TO
TELECOMS”

I, Dorothy Hauser, hereby certify that this correspondence is being electronically filed on the United States Patent and Trademark Office's EFS-web with the Commissioner for Patents on the date of my signature.


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June 7, 2010
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APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the final Office action dated February 19, 2010 and after the Notice of Appeal filed April 6, 2010. The Appeal Brief is filed within the two-month period for response. In the event Applicant has overlooked the need for an extension of time, please consider this a request for the same. Please charge the fee required under 37 C.F.R. 41.20(b)(2) and any other fee associated with this Appeal Brief or credit any overpayment to Deposit Account No. 13-3080.

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REAL PARTY-IN-INTEREST

The real party in interest is Host Telecom Limited, having an address at 1Park House 200 Drake Street 713 Rochdale, Lancashire, United Kingdom OL16 1PJ, as evidenced by the Assignment recorded September 17, 2008 at reel/frame 021543/0001.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1, 4-8 and 18-25 are pending and are attached in the Claims Appendix. Claims 2-3, 9-17 and 26-34 were previously cancelled without prejudice. Pending claims 1, 4-8 and 18-25 stand finally rejected by the Examiner. Applicant appeals the final rejection of claims 1, 4-8 and 18-25.

STATUS OF AMENDMENTS

No amendments were made subsequent to the final rejection mailed February 19, 2010.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a method for transmitting pre-recorded images using telecom networks, the method comprising the steps of detecting when a telecommunications apparatus 1 is used by a caller to send a message to a recipient. Page 7, lines 6-13; Fig. 1. The method also includes the steps of establishing a connection with a telecommunications apparatus 2 of the recipient and, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to conventional connection messages. Page 1, lines 27-29, page 7, lines 11-13; page 8, lines 21-23; page 9, lines 24-32; Fig. 1. In addition, the method includes the step of, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Page 2, lines 4-7. The method also includes the step of, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated. Page 2, lines 9-13.

Claims 4-8 depend from independent claim 1.

Independent claim 18 is directed to an apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller 10 to send a message to a recipient 70, a supplementary image is visually transmitted from messaging equipment to the caller 10 in addition to, or to replace, conventional connection messages. Page 1, lines 27-29, page 7, lines 11-13; page 8, lines 21-23; page 9, lines 24-32; Fig. 1. The apparatus comprises, means 20 for detecting a signal on a telecom system indicating that there is an incoming message transmission. Page 7, lines 6-13; Fig. 1. The apparatus also includes means for establishing a connection with a telecommunications apparatus of the recipient 70 and means for responding to this detection and connection by conveying a supplementary image or images to the caller 10 in addition to, or to replace, conventional connection messages. Page 1, lines 27-29, page 7, lines 11-13; page 8, lines 21-23; page 9, lines 24-32; Fig. 1. If the recipient 70 does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text. Page 2, lines 4-7. If, during transmission of the supplementary image to the caller 10, a connection is established between the caller 10 and the recipient 70, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated. Page 2, lines 9-13.

Claims 19-25 depend from independent claim 18.

The above description is provided for purposes of illustration and explanation only and should not be regarded as limiting.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration by the Board are as follows:

1. Whether claims 1, 4-8, 18 and 21-25 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,428,670 (“Gregorek”).
2. Whether claims 1, 4-8, 18 and 21-25 are anticipated under 35 U.S.C. § 102(b) by Statutory Invention Registration No. H1714 (“Partridge”).
3. Whether claims 19-20 are unpatentable under 35 U.S.C. § 103(a) over Gregorek in view of U.S. Patent No. 6,205,432 (“Gabbard”).

ARGUMENT

1. Rejection of claims 1, 4-8, 18 and 21-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,428,670 (“Gregorek”)

Independent Claim 1

Independent claim 1 defines

A method for transmitting pre-recorded images using telecom networks, the method comprising the steps of:

detecting when a telecommunications apparatus is used by a caller to send a message to a recipient, establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.

Gregorek discloses a communications marketing system 10 in which a calling party using a first telephone 12 places a call to a called party at with a second telephone 20. The system first determines the status of the second telephone 20, i.e., whether the second telephone is in a busy state or in an idle state. An audible generator or audible signal generator 14 is capable of generating a ringback signal if the called network address or station line is idle, i.e., the second telephone 20 is not in use, or a busy signal if the called network address or station line is busy, i.e., the second telephone 20 is in use. In Gregorek, a message generator 16 is provided to play a series of prerecorded announcements to the calling party for a predetermined period of time.

In Gregorek, if the second telephone is idle, the audible signal generator 14 can produce a conventional audible ringback signal, or the message generator 16 can play a series of prerecorded announcements to the calling party for a predetermined period of time. If the second telephone 20 is busy, the audible signal generator 14 can generate a busy signal, or the message generator 16 can play a series of pre-recorded announcements to the calling party for a predetermined period of time while periodically checking to determine if the second telephone 20 is still busy. This process continues until the second telephone 20 is idle and as long as the

calling party does not abandon the call. If the second telephone 20 is answered, the message generator 16 enters a completed call sequence, and the call is completed. If the call has been abandoned, i.e., the first telephone 12 is on-hook, the message generator 16 also enters a completed call sequence.

Gregorek does not teach or suggest, among other things, a method including establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Gregorek only discloses that the message generator 16 enters the completed call sequence if the second telephone is answered or if the call has been abandoned. Gregorek does not teach or suggest that, after establishing a connection with the second telephone 20, if the second telephone 20 is not answered during a predetermined time period, then replacing the announcement by connection message text. In fact, Gregorek does not teach or suggest that, in any instance, if the second telephone is not answered during a predetermined time period, then replacing the announcement by connection message text. This subject matter is completely absent from Gregorek.

The Examiner contends that an “if-then” claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the ‘if-then’ claim limitation.” Office Action, dated February 19, 2010, page 2. Applicant disagrees and submits that the Examiner is ignoring the clear language of the claim which requires both that “if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text” **and** that “if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.” Accordingly, in order to anticipate or render obvious the claim, Gregorek must teach or suggest both limitations. As discussed above, Applicant submits that Gregorek at least does not teach or suggest that if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Again, this subject matter is completely absent from Gregorek.

For at least these independent reasons, Gregorek does not teach or suggest the subject matter defined by independent claim 1. Accordingly, Applicant respectfully requests reversal of the rejection of claim 1 as being anticipated by Gregorek under 35 U.S.C. §102(b). Dependent claims 4-8 depend from independent claim 1 and are allowable for at least the same and other independent reasons.

Independent Claim 18

Independent claim 18 defines

An apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller to send a message to a recipient, a supplementary image is visually transmitted from messaging equipment to the caller in addition to, or to replace, conventional connection messages, wherein the apparatus comprises:

means for detecting a signal on a telecom system indicating that there is an incoming message transmission;

means for establishing a connection with a telecommunications apparatus of the recipient;

and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated.

Gregorek does not teach or suggest, among other things, an apparatus including means for establishing a connection with a telecommunications apparatus of the recipient, and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then the means for responding to this detection

and connection replacing the supplementary image by connection message text. Gregorek only discloses that the message generator 16 enters the completed call sequence if the second telephone is answered or if the call has been abandoned. Gregorek does not teach or suggest that, after a connection with the second telephone 20 is established, if the second telephone 20 is not answered during a predetermined time period, then replacing the announcement by connection message text. In fact, Gregorek also does not teach or suggest that, if the second telephone 20 is not answered during a predetermined time period, then any means for responding to this detection and connection replacing the supplementary image by connection message text. This subject matter is completely absent from Gregorek.

As discussed above, the Examiner contends that an “if-then” claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the ‘if-then’ claim limitation.” Office Action, dated February 19, 2010, page 2. Applicant again disagrees and submits that the Examiner is ignoring the clear language of the claim which requires both “if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text” **and** “if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated.” Accordingly, in order to anticipate the claim, Gregorek must teach both limitations. As discussed above, Applicant submits that Gregorek at least does not teach or suggest that if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text. Again, this subject matter is completely absent from Gregorek.

For at least these independent reasons, Gregorek does not teach or suggest the subject matter defined by independent claim 18. Accordingly, Applicant respectfully requests reversal of the rejection of claim 18 as being anticipated by Gregorek under 35 U.S.C. §102(b). Dependent claims 19-25 depend from independent claim 18 and are allowable for at least the same and other independent reasons.

2. Rejection of claims 1, 4-8, 18 and 21-25 under 35 U.S.C. § 102(b) as being anticipated by Statutory Invention Registration No. H1714 (“Partridge”)

Independent Claim 1

The language of independent claim 1 is presented above and in the Claims Appendix.

Partridge discloses automatic still image transmission upon call connection for a “caller ID”. In Partridge, a customer preselects or pre-approves one or more stored images that the customer wants to be displayed as its “telephone calling card” to parties it calls. Col. 2, lines 53-65.

In operation, the customer (calling party at terminal 10) calls another party (at called terminal 80). Image processor 60 retrieves a stored image (selected or pre-approved by the customer or associated with the customer) from the image storage unit 50 and transmits the image to the called terminal 80. Col. 5, lines 29-32, 48-51. The image can be transmitted upon establishment of a path to called terminal 80, before or with the first ring, after a number of rings, or after the called party answers. Col. 5, lines 51-64.

Partridge does not teach or suggest, among other things, a method for transmitting pre-recorded images using telecom networks, the method including displaying on the caller equipment a supplementary image to replace conventional connection messages. There is no teaching or suggestion in Partridge to display on the caller equipment a supplementary image. As discussed above, Partridge is directed to a “caller ID” with stored images only being displayed as a calling party’s “telephone calling card” to parties it calls.

Partridge also does not teach or suggest such a method in which, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Partridge is completely silent as to what happens if the called party does not answer during a predetermined time period. In addition, Partridge does not teach or suggest that, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated. In contrast, Partridge discloses that the image may continue to be transmitted after the called party answers. Col. 5, lines 60-64.

For at least these independent reasons, Partridge does not teach or suggest the subject matter defined by independent claim 1. Accordingly, Applicant respectfully requests reversal of the rejection of claim 1 as being anticipated by Partridge under 35 U.S.C. §102(b). Dependent

claims 4-8 depend from independent claim 1 and are allowable for at least the same and other independent reasons.

Independent Claim 18

The language of independent claim 18 is presented above and in the Claims Appendix.

Partridge does not teach or suggest, among other things, an apparatus used for transmitting pre-recorded images using telecom networks, the apparatus comprising means for responding to detection and connection by conveying a supplementary image or images to the caller on the caller equipment a supplementary image to replace conventional connection messages. There is no teaching or suggestion in Partridge by conveying a supplementary image or images to the caller on the caller equipment a supplementary image to replace conventional connection messages. As discussed above, Partridge is directed to a “caller ID” with stored images only being displayed as a calling party’s “telephone calling card” to parties it calls.

Partridge also does not teach or suggest such an apparatus in which, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Partridge is completely silent as to what happens if the called party does not answer during a predetermined time period.

In addition, Partridge does not teach or suggest that, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated. supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated. In contrast, Partridge discloses that the image may continue to be transmitted after the called party answers. Col. 5, lines 60-64.

For at least these independent reasons, Partridge does not teach or suggest the subject matter defined by independent claim 18. Accordingly, Applicant respectfully requests reversal of the rejection of claim 1 as being anticipated by Partridge under 35 U.S.C. §102(b). Dependent claims 19-25 depend from independent claim 18 and are allowable for at least the same and other independent reasons.

3. Rejection of claims 19-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,428,670 (“Gregorek”) in view of U.S. Patent No. 6,205,432 (“Gabbard”)

Dependent Claim 19

Dependent claim 19 depends from independent claim 18 and specifies that the apparatus is arranged to insert a supplementary image or images into the message and relay the message with inserted supplementary image(s) to a recipient. Dependent claim 20 depends from dependent claim 19 and further specifies that in the case of text messaging the supplementary image(s) is/are inserted in a part of a message from the caller and will be visible to the recipient on retrieval of the text message. As discussed above, Gregorek does not teach or suggest the subject matter defined by independent claim 18. Gabbard does not cure the deficiencies of Gregorek.

Gabbard discloses an advertisement system and method for inserting into an end-users communication message or email a background message to an advertisement. The background message causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an email message or public posting.

The combination of Gregorek and Gabbard suggested by the Examiner still fails to teach or suggest at least an apparatus used for transmitting pre-recorded images using telecom networks, the apparatus comprising means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated. Applicant respectfully submits that even the addition of subject matter arguably disclosed in Gabbard to the communications marketing system 10 of Gregorek does not cure these deficiencies.

For at least these independent reasons, the Examiner has failed to present a *prima facie* case of obviousness as required by 35 U.S.C. §103. Accordingly, Applicant respectfully requests reversal of the rejection of claims 19-20 as being obvious over Gregorek in view of Gabbard under 35 U.S.C. §103

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Board reverse the rejections under 35 U.S.C. § 102(b) and 103 and pass the application to allowance.

If consultation with Applicant's attorney will further prosecution, the undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

/Edward R. Lawson Jr./

Edward R. Lawson Jr.
Reg. No. 41,931

File No. 013344-9025-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, WI 53202-4108
Phone: 414-271-6560

CLAIMS APPENDIX

1. A method for transmitting pre-recorded images using telecom networks, the method comprising the steps of: detecting when a telecommunications apparatus is used by a caller to send a message to a recipient, establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.

4. The method of claim 1, wherein a message to be transmitted to the recipient from the caller is a mixed media audio/video message and, wherein a supplementary image is presented for viewing to the caller prior to connection between caller and recipient being established or prior to transmission of the message from the caller.

5. The method of claim 1, wherein the image has at least one of an advertising content, an information content, or a combination thereof.

6. The method of claim 1, wherein a supplementary image is presented for viewing to the caller prior to connection between caller and recipient being established.

7. The method of claim 1, wherein supplementary images are conveyed only to telecom system users who have indicated a willingness to receive such images.

8. The method of claim 1, wherein supplementary image insertion is available to all network service providers.

18. Apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller to send a message to a recipient, a supplementary image is visually transmitted from messaging equipment to the caller in addition to, or to replace, conventional connection messages, wherein the apparatus comprises: means for detecting a signal on a telecom system indicating that there is an incoming message transmission; means for establishing a connection with a telecommunications apparatus of the recipient; and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated.

19. The apparatus according to claim 18, wherein the apparatus is arranged to insert a supplementary image or images into the message and relay the message with inserted supplementary image(s) to a recipient.

20. The apparatus of claim 19, wherein in the case of text messaging the supplementary image(s) is/are inserted in a part of a message from the caller and will be visible to the recipient on retrieval of the text message.

21. The apparatus of claim 18, wherein a message to be transmitted to the recipient from the caller is a mixed media audio/video message and, wherein a supplementary image is presented for viewing to the caller prior to connection between caller and recipient being established or prior to transmission of the message from the caller.

22. The apparatus of claim 18, wherein the apparatus comprises cellular/wired telecommunications systems and other terrestrial or satellite transmissions, or email transmission systems capable of receiving text messaging.

23. The apparatus of claim 22, wherein the telecommunications system is configured so as to convey such supplementary images only to system users who have indicated a willingness to receive such images.

24. The apparatus of claim 18, wherein the supplementary image also has an audible message associated with it and transmitted to the caller during a predetermined time period.

25. The apparatus of claim 24, wherein the predetermined time period is selected by an advertising organisation.

EVIDENCE APPENDIX

No evidence is submitted in this Appeal.

RELATED PROCEEDINGS APPENDIX

None.